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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/699,167	10/27/2000	Bruce Douglas Pomeroy	RD-28,110/USA	8459

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GENERAL ELECTRIC COMPANY
GLOBAL RESEARCH
PATENT DOCKET RM. BLDG. K1-4A59
NISKAYUNA, NY 12309

EXAMINER

BLECK, CAROLYN M

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/699,167

Applicant(s)

POMEROY ET AL.

Examiner

Carolyn M Bleck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26, 45 and 46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 20 December 2004. Claims 1-26, 45, and 46 are pending. None of the pending claims have been amended.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-26 and 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCallum (5,784,635) in view of Wood et al. (5,851,186) and Kawasaki (6,539,375), for the same reasons given in the previous Office Action (dated 21 September 2004).

(A) Claims 1-26 and 45-46 have not been amended and are rejected for the same reasons given in the prior Office Action (dated 21 September 2004; sections 3(A)-3(O)).

Response to Arguments

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4. Applicant's arguments filed 20 December 2004 have been fully considered but they are not persuasive. Applicant's arguments will be addressed below in the order in which they appear in the response filed 20 December 2004.

(A) At pages 2-3 of the response filed 20 December 2004, Applicant argues that Applicant's invention is not obvious in view of the applied references, taken individually or in combination.

In response, the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that she has at least satisfied the burden of presenting a *prima facie* case of obviousness, since she has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (see paper dated 21 September 2004). Note, for example, the motivation explicitly stated at page 4 of the previous Office Action (i.e., "...allowing remote access of patient images from anywhere in the world (Wood; col. 1 lines 42-67) thus increasing the quality of health care by allowing patients to get second opinions from other physicians and reducing the cost of providing health care for

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physicians by allowing them to increase the number of patients examined (McCallum; col. 1 lines 20-33)) which is based on the teachings of the applied prior art.

(B) At pages 2-4 of the response filed 21 December 2004, Applicant argues that certain features of the claimed invention are not taught by the applied reference. In particular, Applicant argues that the references do not disclose automatically screening the examination data for errors.

In response, the Examiner respectfully notes that the cited reference was never applied as a reference under 35 U.S.C. 102 against the pending claims. As such, the Examiner respectfully submits that the issue at hand is not whether the applied prior art specifically teaches the claimed features, *per se*, but rather, whether or not the prior art, when taken in combination with the knowledge of average skill in the art, would put the artisan in possession of these features. Regarding this issue, it is well established that references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969). The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir.

1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

According to *Ex parte Berins*, 168 USPQ 374 (Bd. Appeals), there is no statutory limitation as to the number of references that may be used to demonstrate obviousness...not what references expressly state but what they would reasonably suggest to one of ordinary skill in the art. In *In re Conrad*, 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In reference to Applicant's specific arguments with respect to the McCallum reference, the Examiner respectfully submits that Applicant's statements appear to be misdescriptive of the full teachings of McCallum. In particular, Applicant appears to argue that Fig. 6-9, col. 12 lines 50-55, and col. 13 lines 22-44 of McCallum do not teach Applicant's claimed feature of

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“automatically screening the examination data for errors.” However, the Examiner did not rely on those portions of McCallum for the teaching of that feature. The Applicant is referred to the rejection of claim 1 under subsection d for the disclosure of this feature. Note: “cleaning up the anomalies such as inconsistent syntax, data keying errors, or information missing/ omitted, wherein the data cleaning includes comparing data to standardized information resources such as AMA ICD9 tables, AMA DRG tables, AMA CPT tables, US postal zip codes, standardized fee schedules, state medical examiner’s databases, AMA relative value scales, and AHA databases (Fig. 3, col. 7 lines 6-33).” In addition, McCallum discusses these features in Figure 1. The Examiner respectfully submits that this disclosure of McCallum clearly discloses Applicant’s claimed feature of “automatically screening the examination data for errors.”

(C) Applicant also appears to argue that the applied references do not teach a means for automatically screening examination data for errors “in order to provide reports on medical imaging.” Applicant also argues on page 4 that Applicant’s invention “enables the scanning of examination data in a file, in order to determine if a file contains all of the exams that should have been acquired from each scanner, during a particular examination” and that “the files are screened to determine if there is missing examination data that is critical to the reporting within a given file.”

In response to Applicant's argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which

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applicant relies (i.e., "in order to provide reports on medical imaging," "enables the scanning of examination data in a file, in order to determine if a file contains all of the exams that should have been acquired from each scanner, during a particular examination," and "the files are screened to determine if there is missing examination data that is critical to the reporting within a given file") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). It is further noted that Applicant does not disclose in the pending claims what errors the method is screening for. In this case, Applicant discusses that the invention screens to determine if a file contains all of the exams that should have been acquired from each scanner. If this is the type of error the method or system is screening for, it is suggested that Applicant amend the claims to better reflect Applicant's claimed invention.

(D) In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner provided motivations directly from

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the references themselves. Note, for example, the motivation explicitly stated at page 4 of the previous Office Action (i.e., "...allowing remote access of patient images from anywhere in the world (Wood; col. 1 lines 42-67) thus increasing the quality of health care by allowing patients to get second opinions from other physicians and reducing the cost of providing health care for physicians by allowing them to increase the number of patients examined (McCallum; col. 1 lines 20-33)) which is based on the teachings of the applied prior art.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (703) 305-3981. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (703) 305-9588.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 306-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

6. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 872-9306 or (703) 872-9326	[Official communications]
(703) 872-9327	[After Final communications labeled "Box AF"]
(703) 746-8374	[Informal/ Draft communications, labeled "PROPOSED" or "DRAFT"]

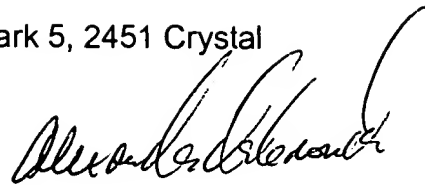
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Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor (Receptionist).

CB

CB

January 26, 2005



ALEXANDER KALINOWSKI
PRIMARY EXAMINER